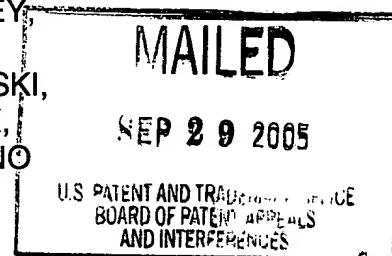


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte MAY SHANA'A, MICHAEL C. CHENEY,
ROBERT AVENA, KEVIN KEATING,
CRAIG S. SLAVTCHEFF, BRIAN J. DOBKOWSKI,
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Appeal No. 2005-1428
Application No. 09/930,320

ON BRIEF

Before ELLIS, ADAMS, and GRIMES, Administrative Patent Judges.

GRIMES, Administrative Patent Judge.

DECISION ON APPEAL

This appeal involves claims to a method of providing a customized personal care product. The examiner has rejected the claims as obvious in view of the prior art. We have jurisdiction under 35 U.S.C. § 134. Because the cited references would have suggested the claimed method, we affirm.

Background

The specification discloses a "system that enables a user to formulate a variety of personal care product compositions to best suit the needs of the consumer." Page 1.

The system comprises providing a selection of personal care base compositions and a plurality of variants from two or more classes of performance agents. . . . Variants as used herein are defined as distinct members of a single class of performance agent which may be selected from such classes as botanical extracts, emollients, vegetable oils, active agents for treating or preventing skin disorders, vitamins, and the like. Variants may differ from each other with respect to either the identity (e.g. vitamin E acetate and vitamin A palmitate), or in the concentration of the aforementioned components.

Page 2.

“[P]ersonal care product base compositions include cleansing and conditioning product bases useful for formulating body wash, body lotion, . . . hair shampoo, hair conditioner,” etc. Page 3. “One class of performance agents may typically be fragrances.” Page 6. “Other classes of performance agents . . . may include a colorant, and a benefit agent. Inventive benefit agents include emollients, botanical extracts, vitamins, other active ingredients to prevent or treat undesired skin and hair conditions, and the like.” Pages 6-7.

“The consumer is allowed to select, in any sequence, one personal care base composition and at least two variants from separate classes of performance agents, such as a fragrance and a benefit agent. The user doses, in any sequence, the consumer selected personal care base composition, performance agents, and, if necessary, sufficient vehicle into a container, [and] mixes the contents until uniform.”

Page 2.

Discussion

1. Claim construction

Claims 1-11 and 13-29 are pending and on appeal. The claims subject to each rejection stand or fall together. See the Appeal Brief, page 6. We will focus on claims 1

and 24 as representative. Claims 2-11, 13-22, and 25-29 stand or fall with claim 1, and claim 23 stands or falls with claim 24.

Claims 1, 22, and 24 read as follows:

1. A method for providing a customized, personal care product to a consumer at a location remote from a second location in which a personal care product base composition is prepared, comprising:

(a) providing a selection from a plurality of said personal care base compositions;

(b) providing a selection from a plurality of variants from a first class of performance agents, each of said variants being delivered in a first vehicle, said first vehicle for each of said variants having at least two ingredients in common with each other, said first vehicle being compatible with a mixture of said personal care base composition and a second class of performance agents different from the first class;

(c) providing a selection from a plurality of variants of said second class of a performance agents, each of said variants being delivered in a second vehicle, said second vehicle for each of said variants having at least two ingredients in common with each other;

(d) permitting the consumer to select, in any sequence, said at least one personal care base composition; at least one variant from said first class of performance agents; and at least one variant from said second class of performance agents;

(e) dosing, in a predetermined sequence, the consumer selected personal care base composition and performance agents into a container to form a personal care product;

(f) mixing said personal care product until the product is uniform; wherein said first and second class of performance agents are independently selected from fragrances, colorants, benefit agents and blends thereof.

22. The method of claim 1 where said container has a volume under about 1 liter.

24. The method of claim 22 wherein said container has a neck; a cap without an orifice is used to cap said container to improve mixing efficiency when said container's contents are blended by a mixing device while said container is situated in a position substantially inverted from its filling position.

Claim 1 is directed to a method for providing a customized personal care product to a consumer at a location different from where the base composition is prepared. The method comprises providing a plurality (i.e., at least two) base compositions and a plurality of variants from two classes of performance agents. The performance agents are “fragrances, colorants, benefit agents [or] blends thereof” and the vehicles for the variants within each class have at least two ingredients in common. The consumer is allowed to choose a base composition and a variant from each class of performance agents, then the selections are dosed into a container and mixed.

Claim 24 adds the limitations that the container has a volume of less than one liter (claim 22) and has a neck and a cap without an orifice (claim 24).

2. Obviousness – claim 1

The examiner rejected claims 1-11, 13-22, and 25-29 under 35 U.S.C. § 103 as obvious in view of Rath,¹ Rigg,² and Stewart.³ Rigg and Stewart were cited only to meet limitations in the dependent claims. We conclude that Rath, alone, would have made the method of claim 1 prima facie obvious. Therefore we will not further discuss Rigg or Stewart.

Rath teaches that hair care products are available as prepared formulations. “A drawback of such products is that the user cannot alter the formulation to accommodate their particular hair characteristics or to provide specialized treatment.” Col. 1, lines 11-14. Rath “provide[s] a system which enables a user to formulate a variety of shampoos,

¹ Rath et al., U.S. Patent 5,972,322, issued October 26, 1999.

² Rigg et al., U.S. Patent 5,622,692, issued April 22, 1997.

³ Stewart, PCT application WO 98/30189, published July 16, 1998.

hair conditioners or styling compositions to best suit the hair care needs of the user.”

Col. 1, lines 22-25.

More specifically, Rath discloses “a system for formulating customized hair care products, such as hair shampoo, conditioner, and styling compositions. The hair care system is composed of separately packaged components, including a low-viscosity aqueous base composition, a compatible thickening composition and, optionally, one or more enhancing additives.” Col. 2, lines 48-54.

“Examples of suitable enhancing additives include a shine enhancer, oil-based moisturizer, herbal additive, hair strengthener, vitamin additive, colorant, body building and conditioning polymers, natural or synthetic fragrance oils (aroma), UV absorbers, and dandruff control compounds.” Col. 9, lines 30-35. Rath teaches exemplary compositions for a “stimulating or astringent herbal additive” and a “soothing herbal additive” (columns 19-20); both compositions have vehicles with at least two ingredients in common. Rath also teaches exemplary color concentrate compositions (columns 20 through 23); all of the compositions have vehicles with at least two ingredients in common.

Rath teaches that the base, thickener, and additive components are provided separately, together with instructions (col. 13, lines 31-35). “The instructions can provide one or more formulations of the components, including combinations of the base with the thickener and desired enhancing additives, to achieve a desired shampoo, conditioner or styling composition.” Col. 13, lines 36-40. “[T]he base . . . is combined with the desired enhancing additives. The ingredients are typically mixed together by vigorous shaking. . . . A predetermined amount of thickener is then added to

the low viscosity mixture, [and] the mixture is vigorously shaken to provide a homogeneous mixture.” Col. 13, lines 53-60.

We agree with the examiner that the instantly claimed method would have been obvious in view of Rath. Specifically, Rath would have made obvious to a person of ordinary skill in the art a hair care system comprising a plurality of base compositions (e.g., shampoo base and conditioner base), a thickener, and a plurality of performance agents selected from at least two classes of performance agents (e.g., the two herbal additive compositions in columns 19-20 and two or more of the color concentrates in columns 20-23). According to Rath's disclosure, the user would select the desired additives, combine them with the appropriate base (shampoo base for making shampoo, conditioner base for making conditioner) and mix, then add thickener and mix again. The system and method made obvious by Rath meets all of the limitations of instant claim 1.

Appellants argue that “Rath et al. teaches away from the present invention where the inventive base composition (where appropriate) already comprises a thickening agent . . . and was formulated at a location remote from the location that the finished personal care product is prepared in.” Appeal Brief, page 6. See also page 7: “[T]hickening agents are separately defined as being part of the base composition . . . and as stated above must be added to the base composition at a location that is different than where the performance agents are added.”

We are not persuaded that Rath's separate packaging of “base” and “thickener” distinguishes the prior art method from the claimed method. The specification states:

Personal care product base compositions useful in the invention typically contain one or more of the following: a solvent such as water . . . ; soaps, surfactants, . . . and the like; conditioning agents . . . ; thickening agents

such as acrylates, polysaccharide polymers, and the like; lathering aids . . .; emollients . . .; pH adjusters, and preservatives.

Pages 4-5. Rath's method involves base compositions comprising, among other things, water and either surfactants or conditioning agents. See columns 3 and 5. The specification does not define a "base composition" as one that necessarily contains a thickener and therefore does not distinguish the claimed method from the one taught by Rath.

Appellants also argue that "[t]he consumer is not intended to be involved in the packaging of the kits disclosed in Rath et al., but only in the possible mixing of certain kit components. In contrast, . . . in the present invention, the component parts of the product are not dictated by the prepackaged kit . . . but by the precise needs of the consumer." Appeal Brief, page 7.

We also find this argument unpersuasive. Rath discloses that "one objective of the invention is to provide a system which enables a user to formulate a variety of shampoos, hair conditioners or styling compositions to best suit the hair care needs of the user." Col. 1, lines 22-25. Rath also teaches that "[t]o prepare the hair care composition, the base . . . is combined with the desired enhancing additives," and mixed. Col. 13, lines 53-56. In view of these disclosures, Rath would have been read by those skilled in the art to suggest a method in which the user of the hair care composition chooses desired enhancing additives from among a plurality of them, combines them with a base composition, and mixes them.

Finally, Appellants argue that, as defined in the instant specification, a thickener is not an enhancing agent. See the Appeal Brief, pages 8 and 9.

We agree with Appellants that the specification defines a thickener as a possible constituent of the base composition, not a performance agent or (in Rath's terms) an enhancing additive. We do not see how that issue affects the outcome of the analysis, however. Even if Rath's thickener is considered a part of the base and not an enhancing additive, the method suggested by Rath meets all of the limitations of instant claim 1.

3. Obviousness – claim 24

The examiner rejected claims 23 and 24 under 35 U.S.C. § 103 as obvious in view of Rath, Rigg, Stewart, and Tartaglione.⁴ As noted above, claim 23 will stand or fall with claim 24. Claim 24 is directed to the method of claim 1, where the container has a volume of less than one liter, and has a neck and a cap without an orifice. Tartaglione discloses a bottle with a neck (see Figure 2) that is threaded “to receive a removable cap.” Col. 3, lines 39-41. The “cap 14 is integrally molded so that it can be bent down to close the hole 13” (col. 3, lines 56-58) that is, the cap lacks an orifice. Although Tartaglione is silent with respect to the volume of the disclosed bottles, it states that they are suitable for shampoo (col. 4, lines 2-3^o); we can take official notice that shampoos are typically packaged in containers of one liter or less.

A person of ordinary skill in the art would have found it obvious to mix Rath's customized shampoo or conditioner compositions in a container having a volume of less than one liter, having a neck, and having a cap without an orifice, such as the bottles taught by Tartaglione. Such bottle shapes and sizes are typical of those used for

⁴ Tartaglione et al., U.S. Patent 4,851,062, issued July 25, 1989.

shampoo and conditioner compositions and well within the level of ordinary skill in the art to utilize.

Appellants argue that "Tartaglione does not disclose how personal care products can be custom formulated nor the relationship of the ingredients that are required by the inventive method of custom formulating such products." Appeal Brief, page 11.

Appellants' argument fails to address the combined teachings of the references. As discussed above, Rath would have suggested the method of claim 1 and Tartaglione would have suggested the limitations added by claim 24. We agree with the examiner that the combined references would have suggested all the limitations of the claimed invention.

Summary

We affirm the examiner's rejections. Since our reasoning differs from that of the examiner, however, we designate our affirmances as new grounds of rejection under 37 CFR § 41.50(b). See In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976).

Time Period for Response




This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

37 CFR § 41.50(b)

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Administrative Patent Judge)	
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